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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,537	09/14/2005	Hans Vondracek	103020.59950US	4431

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EXAMINER

YANG, JIE

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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04/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,537	Applicant(s) VONDRACEK ET AL.	
	Examiner JIE YANG	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 21 and 24-44 is/are pending in the application.
- 4a) Of the above claim(s) 26-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21, 24, and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 26-44 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18, 21, 24, and 25, drawn to a method for thermomechanical treat of steel rods.

Group II, claim(s) 26-44, drawn to a method for producing steel coil spring or stabilizers.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: they lack the same unity a posteriori because the common feature of “thermomechanical treat of steel rods” is known in the art. Bilgen (DE 19839383 used hereinafter with English equivalent US 6,458,226, thereafter US’226) discloses a process for the thermomechanical treat of steel (Abstract, Summary of the invention section, Col.3, lines 31-59 and claims 1-2 of US’226). Invention I-II lacks the same or corresponding special technical feature. Therefore unity of invention is lacking and restriction is appropriate.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 19, 20, 22, and 23 have been cancelled; claims 1, 7, 10, 13, 15, 16, 24, and 25 have been amended; the newly added claims 26-44 are withdrawn as non-elected claims; and claims 1-18, 21, 24, and 25 are pending in application.

Status of the Precious Rejection

Previous objections of claims 1 and 17 have been withdrawn in view of the amendment and remark filed on 1/8/2009.

Previous rejections of claims 1, 7, 10, 12, 13, 16, and 25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn in view of the amendment and remark filed on 1/8/2009.

The previous rejection of claims 1-18, 21, 24, and 25 under provisional obviousness-type double patenting over claims 1-17 of copending application 10/551538 have been withdrawn because 10/551538 has been abandoned.

The previous rejections of claims 1-15, 17, 18, 21, 24, and 25 under 35 U.S.C. 103(a) as being unpatentable over US'226 in view of Hathaway (US 2,261,878)

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have been withdrawn in view of the amendment and remark filed on 1/8/2009.

However, in view of the amendment, a new ground(s) of rejection is made (see below).

The previous rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over US'226 in view of Hathaway (US 2,261,878) and further in view of Borowikow (DE 100 30 823) has been withdrawn in view of the amendment and remark filed on 1/8/2009. However, in view of the amendment and newly found prior art, a new ground(s) of rejection is made (see below).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-18, 21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilgen et al (DE 19839383 used hereinafter with English equivalent US 6,458,226, thereafter US'226) in view of Hathaway (US 2,261,878, thereafter US'878) and Fritz et al (NPL "Fertigungs Technik" (Manufacturing Technology) 1995, and English translation for Fig.5-24 and 5-26, thereafter NPL-1).

Bilgen (US'226) in view of Hathaway (US'878) is applied to claims 1-18, 21, 24, and 25 for the same reason as stated in the previous office action marked 8/8/2008.

Still regarding claims 1 and 25, US'226 in view of US'878 does not specify the limitation of skew rolling. However, skew rolling is a well-known rolling method which is evidenced by NPL-1 (as an Applicants administrated prior art—refer to the "Applicant arguments/remarks made in an amendment" filed on 1/8/2009; the Examiner notes that the Applicants provide the word explanation: phrase "skew rolling" is an English translation of German word "Schragwalzen" and in NPL-1, this phrase is translated as "cross rolling"). NPL-1 teaches skew rolling for the tubes and/or rods (English translation for Fig. 5-24 and 5-26 of NPL-1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the well-known skew-rolling method as evidenced by NPL-1 in the process of US'226 in view of US'878 in order to obtain desired roughness of the product (English translation for Fig. 5-24 of NPL-1).

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'226 in view of US'878 and NPL-1, as applied on claims 1-6, 8-18, 21, 24, and 25 and further in view of Borowikow (DE 100 30 823, thereafter DE'823).

Bilgen (US'226) in view of Hathaway (US'878) and further in view of DE'823 is applied to claim 16 for the same reason as stated in the previous office action marked 8/8/2008.

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Claim 7 is amended to be dependent on claim 16. Regarding the limitation of skew rolling, which is the same limitation as discussed in the rejection for claim 1. Therefore, claims 7 and 16 are rendered obvious over US'226 in view of US'878 and NPL-1, and further in view of DE'823.

Response to Arguments

Applicant's arguments with respect to claims 1-18, 21, 24, and 25 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the Applicant's arguments filed on 1/8/2009 with respect to claims 1-18, 21, 24, and 25, which are related to the amended features in the instant claims. The Examiner's position is stated as above.

The Applicants argue that all claims of record in this application distinguish over US'226 in view of US'878 for claims 1-18, 21, 24, and 25 or US'226 in view of US'878 and further in view of DE'823 for claim 16 because no skew rolling step is disclosed. In response, the Examiner notes that "skew rolling" is a well-known rolling method which is evidenced by NPL-1 (as an Applicant's administrated prior art—refer to the "Applicant arguments/remarks made in an amendment" filed on 1/8/2009; the Examiner notes the Applicants provide the word explanation: phrase "skew rolling" is an English translation of German word "Schragwalzen" and in NPL-1 this phrase is translated as "cross rolling"). The instant claims would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art.

Conclusion

Applicant's submission of an new reference on 01/09/2009 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/
Supervisory Patent Examiner, Art Unit 1793